

REMARKS

Claims 44-83 and 87-99 are pending. By this Supplemental Amendment, claims 84-86 are cancelled and new claims 97-99 are added. Reconsideration in view of the above amendments and the following remarks is respectfully requested.

Applicant believes that all necessary fees have been paid. However, in the event that any fees are missing or insufficient, please charge the necessary fees to our Deposit Account No. 03-3975, under Atty Dkt. No. 9521/256642, and proceed to consider this Supplemental Amendment.

Applicant appreciates the courtesies extended by Examiner Gerrity and Examiner Huynh to Applicant's undersigned representative during a personal interview conducted on June 4, 2002. The substance of the personal interview is discussed below.

With respect to the rejection of claims 83, 87, 88 under 35 U.S.C. §102(b) by Kubacki et al., Applicant is willing to cancel these claims and pursue them in a continuing application if it will help to expedite allowance of the remaining claims. The Examiner is invited to contact the undersigned if cancellation is requested.

With respect to the rejection of claims 44, 63, 83-88 and 92 under 35 U.S.C. §102(e) by Stasiuk, the Examiners agreed that Stasiuk discloses a coated pull tab that includes a laser etched image thereon, wherein the image is created by localized laser removal of the coated layer to expose an uncoated surface of the pull tab. Stasiuk does not laser engrave metal - it only teaches removal of a non-metal coating to expose the underlying metal (aluminum) layer.

Dependent claim 97 has been added, which recites that the laser engravings extend a finite depth into a metal portion of the metal strip to form marks in at least one of the upper surface and the lower surface of the metal strip. Dependent claim 98 recites that the metal strip has a thickness defined between the upper surface and the lower surface, and the laser engravings extend into a metal portion of the metal strip to a depth that is within the thickness of the metal strip.

With respect to the rejection of claims 44, 45, 56-57, 61-64, 74-76, 81, 82 and 89-96 under 35 U.S.C. §103(a) over Kubacki et al in view of Carlson, Applicant's undersigned representative noted that Kubacki and Carlson are directed to non-analogous arts because 1) they are not from the same field of endeavor, and 2) they are not directed to solving the problems that are solved by the present Applicant. Applicant's concern was with providing a laser for metal in an environment where the material is fed intermittently. By sharp contrast, Carlson is directed to laser marking electrical components that are continuously moved past a

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laser source. Carlson is not concerned with providing laser engraved marks on a work piece when the work piece is in an immobilized condition. Moreover, Carlson is not concerned with laser engraving an opening tab for beverage cans. Also, Kubacki does not disclose the use of a laser for engraving, and was not aware of the problems associated with laser engraving for an intermittently fed strip. Applicant discovered how to apply a laser to an intermittently fed strip used to make beverage cans. See page 3, line 26 to page 4, line 29, and page 8, lines 6 to 32.

Accordingly, the laser system of Carlson cannot be modified to provide laser engraving for an intermittently fed strip without the benefit of Applicant's disclosure and impermissible hindsight. See Grain Processing Corp. v American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988) ("It is impermissible to use the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art"). Moreover, there is no motivation for "picking" and "choosing" among the various elements of Kubacki/Carlson, to the exclusion of other elements, to arrive at the claimed combination. See In re Kamm, 172 USPQ 298, 301, 302 (CCPA 1972) ("It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art").

The Examiners agreed to reconsider the motivation to combine Kubacki and Carlson in the next Office Action.

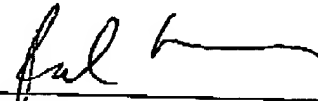
New claim 99 has been added and should be allowable for at least the reasons noted above with respect to claim 44.

Assuming claims 97 and 98 are allowed, similar claims may be added by an Examiner's Amendment to depend from claims 89, 90, 91, 93, and 95 to place the entire application in condition for allowance.

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Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 84-86 have been cancelled.

New claims 97-99 have been added.